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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 920

THEODORE C. GERNER, *Petitioner*

v.

MOOG INDUSTRIES, INC. *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE EIGHTH CIRCUIT

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INDEX

	Page
Petition	1
Opinions Below	1
Jurisdiction	2
Questions Presented for Review	2
Statutes Involved	2
Statement of the Case	3
Reasons for Granting the Writ	6
Conclusion	11

CASES CITED

Graham v. John Deere Co., 383 U.S. 1 ..... 2, 7, 8, 9, 10
Chemical Construction Corp. v. Jones & Laughlin Steel Corp., 311 F. 2d 367 (3rd Cir. 1962) 6, 7, 8
Ensten v. Simon Ascher Co., 282 U.S. 445 ..... 7, 8

STATUTES CITED

28 U.S.C. 1254(1) 2
28 U.S.C. 1338(a) 4
35 U.S.C. 103 ..... 2, 5, 6, 8, 9, 10
35 U.S.C. 253 ..... 3, 6, 7, 8
35 U.S.C. 288 ..... 3, 7

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Petitioner, Theodore C. Gerner, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit which held the Gerner patent No. 3,044,798 invalid.

OPINIONS BELOW

The opinion of the District Court for the Eastern District of Missouri, Eastern Division, (Record, Vol. I, pp. 138-150) is reported at 254 F.Supp. 969, 149 U.S.P.Q. 891 and is reprinted in Appendix A of this Petition, pp. 1a-13a. The opinion of the Court of Appeals for the Eighth Circuit (Record, Vol. III, pp. 1-7) is reported at 155 U.S.P.Q. 232 and is reprinted in Appendix B of this Petition, pp. 14a-19a.

JURISDICTION

The judgment of the Court of Appeals was entered on September 19, 1967, and rehearing was denied on November 6, 1967. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED FOR REVIEW

This is a patent infringement suit in which at most only claims 1, 4 and 5 of the Gerner patent were put in issue. The judgment entered by the District Court nevertheless held the Gerner patent invalid without regard to the claims in issue. The Court of Appeals affirmed. The questions presented are:

1. Whether a patent can be adjudicated invalid where only certain of the claims thereof are put in issue;

2. Whether, in considering the condition for patentability under 35 U.S.C. 103, this Court's opinion in *Graham* v. *John Deere Co.*, 383 U.S. 1, requires a specific determination of (a) the scope and content of the prior art; (b) the differences between such prior art and the patent claims in suit; and (c) the level of ordinary skill in the pertinent art.

STATUTES INVOLVED

35 U.S.C. 103. Conditions for Patentability: Non-Obvious Subject Matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. 288. Action for Infringement of a Patent Containing an Invalid Claim

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

STATEMENT OF THE CASE

Petitioner is one of the rapidly disappearing group of private citizens who individually have pioneered the development and commercialization of innovations in the American tradition. Petitioner's small,

privately owned company has survived in the jungle of automotive parts manufacture only through his inventive genius. Petitioner is the inventor and owner of some twenty odd patents granted by the United States Patent Office. (Record, Vol. I, p. 28)

One such patent is U.S. Patent No. 3,044,798 (Record, Vol. II, pp. E1-E6) granted July 17, 1962, for an invention in an idler arm which is an essential component of the steering system for modern automobiles. This patent has seven claims. After Petitioner's company had placed his invented idler arm on the market, it was examined by the design engineers of Respondent and found to overcome the problems of previous idler arms which had plagued the industry. Respondent then placed on the market its version of Petitioner's invention. (Record, Vol. I, pp. 61-62, 66-67)

Action for infringement of the patent was instituted in the U.S. District Court for the Eastern District of Missouri, for the Eastern Division, and jurisdiction was predicated on 28 U.S.C. 1338(a). The District Court recognized that at most only claims 1, 4 and 5 were in issue (Appendix A, p. 1a). On June 8, 1966, Judge Meredith handed down his opinion holding the Gerner patent invalid without reference to any of the claims thereof. The District Court did not enter findings of fact or conclusions of law.

Judge Meredith nowhere identified the statutory provision or provisions upon which he determined invalidity. While a number of the prior patents were briefly considered, no attempt was made to anlayze the scope and content of the prior art and then determine what differences were defined in the Gerner

patent claims. The only statements made by the District Court which contain a comparative note are, "Gerner is basically a slightly different arrangement of the art which is already patented or in the public domain" (Appendix A, p. 8a), "it is clear to anyone skilled or unskilled how little variation in fact exists between Gerner and the prior art" (Appendix A, p. 8a), and "the Gerner patent when considered with the prior art and particularly that not cited by the Patent Office is invalid because the combination of old elements is obvious to anyone with ordinary mechanical skill" (Appendix A, p. 9a). Comparison with any of the patent claims in suit was totally overlooked.

Furthermore, Judge Meredith omitted any articulation of what he considered to be the level of ordinary skill in the pertinent art of automotive parts design. The District Court rendered no decision on the question of infringement.

The judgment entered by the District Court stated, "U.S. Patent No. 3,044,798, owned by Plaintiff Gerner, is invalid." (Record, Vol. I, p. 151)

Appeal was taken to the Court of Appeals for the Eighth Circuit. On September 19, 1967, that Court affirmed the District Court "holding invalid" the Gerner patent (Appendix B, p. 19a). The only claim considered by the Appeal Court was claim 1.

The Court below presumably rested its decision on 35 U.S.C. 103 in view of its conclusion,

> We are convinced that the disclosures found in the prior art buttressed by the testimony of the [Respondent's] expert witness provided a proper factual basis for the trial Court's determination

> of obviousness of the claimed invention under 35 U.S.C. § 103. (Appendix B, p. 19a)

However, the Court of Appeals also failed to make any comparison between the prior art references and even claim 1 of the Gerner patent in order to determine the differences which exist. The Court below gave only passing consideration to the critical difference urged by the Petitioner,

> It is argued that the three-section wedge means of Gerner is not disclosed in the prior art but the difference appears to be in configuration only because the prior art discloses upper and lower wedge means, which according to the witnesses perform the same function. (Appendix A, p. 19a)

However, the Appeal Court neglected to identify what witnesses and what testimony it was relying upon. In fact, the testimony was to the reverse because from an engineering standpoint the elements do not perform the same function. (Record, Vol. I, pp. 125-126)

The judgment of the Appeal Court affirmed the judgment of the District Court holding the Gerner patent invalid. Petition for rehearing was denied on November 6, 1967.

REASONS FOR GRANTING THE WRIT

The decision below should be reviewed because it erroneously holds the Gerner patent invalid where at most only a limited number of claims thereof were put in issue. The decision is in clear violation of federal statute, 35 U.S.C. 253, and in conflict with the decision of the Court of Appeals of the Third Circuit in *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367 (3rd Cir. 1962). Furthermore,

the decision has decided a federal question (the validity of the Gerner patent) without following the tenets established by the controlling authority of this Court in *Graham v. John Deere Co.*, 383 U.S. 1. In either event, this Court should grant review.

1. The Gerner patent includes seven claims. The District Court pointed out in its opinion that the instant action was for infringement of Gerner patent claims 1, 4 and 5 (Appendix A, p. 1a). Claims 2, 3, 6 and 7 were clearly not placed in issue in this case.

Section 253 (Title 35, U.S.C.) unequivocally specifies in the first sentence that where one claim of a patent is invalid, this does not render the remaining claims invalid. Section 288 (Title 35, U.S.C.) provides that a patentee may maintain suit for infringement of a valid patent claim even though the patent may contain or have contained (in the event of an earlier disclaimer) an invalid claim. These statutory provisions were enacted to remedy hardship developed by the common law which wholly voided a patent containing an invalid claim.

This Court had occasion to consider these provisions in *Ensten v. Simon Ascher Co.*, 282 U.S. 445. While the holding is directed to the diligence requirement in the then-existing predecessors of § 253 and § 288, it is clear from the opinion that a patent cannot be declared invalid based on an adjudication of only certain claims.

The Third Circuit Court of Appeals in *Chemical Construction Corp v. Jones & Laughlin Steel Corp.*, supra, specifically refused to adjudge claims of the patent in suit which had not been put in issue. The only claims of the Johnstone et al patent in issue at

the trial were 5, 6, 8 and 9 which were found by the trial court to be invalid. The appellate court affirmed as to these claims, but it specifically rebuked the attack on the remaining claims of the patent. The court pointed out that "any determination as to validity would have been error", because it "would have violated the rights reserved to the [patentee] by the disclaimer statutes" (at 311 F.2d 374).

Hence, the decision by the Court below is in violation of 35 U.S.C. 253, in seeming contravention of this Court's opinion in *Ensten v. Simon Ascher Co.,* supra, and in conflict with the decision of the Third Circuit in *Chemical Construction Corp.* v. *Jones & Laughlin Steel Corp.,* supra.

2. The District Court omitted any identification in its opinion (Appendix A) of the statutory provision or provisions underlying its conclusion that the Gerner patent is invalid. Assuming that the District Court was proceeding under 35 U.S.C. 103, and this appears to be the predicate for the conclusion reached by the Appeal Court below (Appendix B, p. 19a), both the District Court and the Court of Appeals failed to inquire into the basic considerations outlined by this Court in *Graham v. John Deere Co.* (at 383 U.S. 17) for determining the condition of patentability under § 103. In particular, neither Court presented a comparison of the prior art with the limitations defined in any claim of the Gerner patent, nor were any differences considered in light of what the Court deemed the expected skill in the art.

We believe that when a court decides a question of federal rights in conflict with the prior decision of the federal agency empowered by Congressional act

to determine and grant such rights, it is encumbent upon the court to clearly explain the rationale behind its reversal in precisely the manner prescribed for inquiry by this Court. In considering a question of patentability under 35 U.S.C. 103, this Court has cogently spelled out the three basic inquiries,

> [1] the scope and content of the prior art are to be determined;
>
> [2] differences between the prior art and the claims at issue are to be ascertained; and
>
> [3] the level of ordinary skill in the pertinent art resolved. (*Graham* v. *John Deere Co.*, 383 U.S. 1, 17)

Where a court reverses the decision of the Patent Office on patentability under § 103, it should be required to explain its application of the subject matter to these three basic inquiries. If this requirement was not made in *Graham*, its importance to the patent law necessitates its proclamation as soon as possible.

In any event, both the District Court and the Appeal Court failed to articulate their investigation of the Gerner invention as defined in the claims in terms consonant with the inquiries specified by this Court in *Graham*. The requirement of such articulation will lead to a more cogent and understandable statement from the lower courts and necessarily result in fairer decisions in patent litigation.

Further in this regard, it is pointed out that in the eleven decisions of the Eight Circuit Court of Appeals reported in the United States Patent Quarterly since this Court's decision in *Graham*, the Eighth Circuit has reversed the finding of the Patent Office in all

eleven cases and held each and every patent invalid on the basis of § 103.[1] In comparison, in the twenty-six reported decisions of the Court of Appeals for the Seventh Circuit, the Seventh Circuit has held claims in at least 45 percent of the cases valid.[2]

While these statistics in and of themselves are not relevant to the merits of the Gerner patent, they do reveal the great disparity between two contiguous Courts of Appeal on the application of the standards for patentability under § 103 and an important reason for review in this case.

3. The questions presented to this Court are of recurring significance in patent litigation. The disparity in the application of the test of patentability under § 103 by the Court of Appeals makes necessary a reiteration and reinforcement of the basic inquiries set forth in *Graham*. The conflict of the decision below with federal statute and decisions of this Court and other Courts of Appeal and the importance of the test of patentability under 35 U.S.C. 103 make this case peculiarly appropriate for the exercise of this Court's discretionary jurisdiction.

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[1] The reported decisions of the Eighth Circuit are tabulated in Appendix C, pp. 20a-21a.

[2] The reported decisions of the Seventh Circuit are tabulated in Appendix D, pp. 22a-24a.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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